

REMARKS

INTRODUCTION

In accordance with the foregoing, claims 1-23 are pending and under consideration.

REJECTION UNDER 35 U.S.C. §103

Claims 1-23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,787,941 (Takashima).

The Office Action acknowledged that Takashima “does not show the detailed relative position of the magnets and the portions of the coil.” See pg. 2 of the Office Action.

Takashima does not disclose, “...a connection mold connecting the outer mold and the inner mold is formed on at least part of a surface of the non-effective portion of the coil and not on the effective portion,” as claimed, for example in independent claim 1.

Takashima’s alleged teachings relate to a pair of magnets 15 secured to the inner surface of the yokes 9 where the coils are directly below the magnets 15 (Figs. 1 and 8). Col. 1, lines 25-28 of Takashima states:

The carriage 8 is supported by a rotary shaft (not shown), which is set through [the] bearing 36 so that the coil 7 is positioned inside the space and able to rotate about the rotary shaft (*emphasis added*).

The Office Action asserts that “an area between the magnets is an effective portion and an area (where the connection mold resides) outside of the magnets is a non-effective portion.” Further in the first full paragraph on page 3, the Office Action refers the Applicant to “Figs. 8 and 9 with added marks in [the] next page” However, a marked-up illustration of Figs. 8 and 9 was not provided with the Office Action.

Nevertheless, Takashima fails to disclose, “a connection mold connecting the outer mold and the inner mold is formed on at least part of a surface of the non-effective portion of the coil and not on the effective portion,” as claimed, for example in independent claim 1.

As shown in Figs. 8 and 9, the alleged connection mold of Takashima is formed on both the non-effective **and** effective portion. Fig. 9 shows the alleged connection mold extending over the coil 7 and the alleged inner mold 11, which are both directly under the magnets 9a and 9b.

Thus, Takashima fails to disclose, “...a connection mold connecting the outer mold and the inner mold is formed on at least part of a surface of the non-effective portion of the coil and not on the effective portion,” as claimed, for example in independent claim 1. Additionally,

dependent claims 2-4, 7-9, 12-14, 17-19, and 23 recite patentably distinguishing features of their own. For example, dependent claim 2, recites "...wherein the connection mold is formed at an entire surface of the non-effective portion of the coil."

Withdrawal of the foregoing rejections is respectfully requested.

IMPROPER OBVIOUSNESS RATIONALE

The rejection rationale presented in the outstanding Office Action has set forth the rationale that "it would have been obvious at the time the invention was made to one of ordinary skill in the art to apply Takashima's coil with molds into [the] Prior Art's structure disclosed in Fig. 8 [of Takashima]. The rationale is as follows: Takashima shows that the structure in Fig. 8 is a conventional structure and Takashima also stated that his invention is only [to] improve the strength of the coil (col. 2, lines 26-29). One of ordinary skill in the art would use the Prior Art [of Takashima] for Takashima's coil with molds." See pg. 3 of the Office Action.

Thus, the Office Action is setting forth a motivational rationale not supported by the record, but rather based solely on the Examiner's belief of what one skilled in the art may have tried or recognized.

However, to set forth a prima facie §103 rejection, there must be some evidenced reason for modifying a reference. Specifically, there must be evidence, outside of the present application, which motivates, leads, or suggests to one of ordinary skill to modify a reference. In addition, an "obvious to try" rationale for combining two references is not valid motivation under 35 USC §103. In re Goodwin, 576 F.2d 375, 377, 198 USPQ 1, 3 (CCPA 1978); In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977); In re Tomlinson, 363 F.2d 928, 150 USPQ 623 (CCPA 1966).

MPEP § 2142 states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper."

The Examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." Dembiczak, 50 USPQ2d at 1617. "The factual inquiry whether to combine the references must be thorough and searching." In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing McGinley v. Franklin Sports, Inc., 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The

factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. Id. at 1433-34. The Examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

Further, it is well settled that "the Board [and Examiner] cannot simply reach conclusions based on [their] own understanding or experience - or on [their] assessment of what would be basic knowledge or common sense. Rather the Board [and Examiner] must point to some concrete evidence in the record in support of these findings." In re Zurko, 258 F. 3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). See also In re Lee, 277 F. 3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), in which the court required evidence for the determination of unpatentability by clarifying that the principles of "**common knowledge**" and "**common sense**" may only be applied to the analysis of evidence, rather than be a substitute for evidence.

Thus, accordingly, a prima facie obviousness rejection requires evidenced motivation from something in the record that would lead one skilled in the art to combine the relevant teachings, again noting that the mere fact that the prior art may be modified in a particular manner does not make the modification obvious unless the prior art suggested the desirability of that modification.

Contrary to these requirements, the outstanding Office Action merely presents the proposal that the modification of Takashima to include the claimed configuration, which the Office Action has interpreted as being disclosed in Takashima, and concludes the obviousness of the same, without providing support in the record for motivation of the same.

Such motivational conclusions are improper. The relied upon motivation must be evidenced in the record, and cannot be based merely on an opinion of the Examiner.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

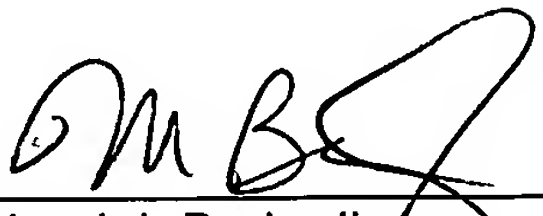
If there are any additional fees associated with filing of this Amendment, please charge

the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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